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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,428	08/07/2001	Lei Wu	4718420005000	3614

25225 7590 05/18/2006

MORRISON & FOERSTER LLP  
12531 HIGH BLUFF DRIVE  
SUITE 100  
SAN DIEGO, CA 92130-2040

EXAMINER

CHEU, CHANGHWA J

ART UNIT PAPER NUMBER

1641

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/924,428

Applicant(s)

WU ET AL.

Examiner

Jacob Cheu

Art Unit

1641

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 05 April 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

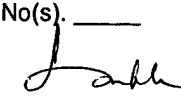
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-14, 16-20, 25-31, 33, 34, 56, 57, 67, 68, 92, 93, 95 and 115-119.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
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Continuation of 11. does NOT place the application in condition for allowance because:

With respect to independent claims 1, 56 and 67, applicant's main arguments rely on the recited feature "wherein said microdevice comprises a magnetic material, or said binding partner comprises a cell, a cellular organelle, a virus, or an antibody" which is missing in the cited prior art Kaye et al. (GB 2 3060484). Without discussing on the merits of the Kaye et al. reference, i.e. whether Kaye et al. explicitly or implicitly teach using such magnetic material in the microdevice, the recited language does not clearly set forth the purported limitation. Examiner would like to point out that applicant uses an "alternative optional" language, i.e. "or", rather than a definite combination wording, e.g. "and". In light of the recited language, the instant microdevice invention can be interpreted as "wherein said microdevice comprises said binding partner comprises a cell, a cellular organelle, a virus, or an antibody" alone without "magnetic materials". Thus, the teachings from Kaye et al. would still read on the instant invention.

Moreover, "assuming" the rejections over Kaye et al. article are overcome, applicant also contemplates the potential obviousness rejection under 35 USC 103 (a). With this concern, applicant also argues that Kaye et al. suggest using chemically inert materials, e.g. gold or aluminum, and quote "[T]he particles should be made of a chemical composition which is not affected by the rigours of library synthesis". Thus, applicant concludes that the disclosure by Kaye et al. reference provides no motivation and in fact may teach away to one ordinary skill in the art to use magnetic materials (See Remarks, page 24). Again, without determining whether Kaye et al. indeed explicitly or implicitly teach away using magnetic materials, examiner would like to point out that applicant recites the microdevice in an "open" language, i.e. comprises. Any part or portion of such device is potentially available for substance or material for making, incorporation or combining. In addition, Kaye et al. merely mention using particles "of a chemical composition which is not affected by the rigours of library synthesis". The same microdevice would be subject to further separation subsequent to synthesis. Using magnetic materials for separation is well-known and widely practiced in the art. It may need further determination with respect to the issue of obviousness under 35 USC 103 (a), albeit this has not been brought up in the previous Office Action.

Finally, applicant also argues that Kaye et al. do not explicitly teach using a binding partner comprises a cell, a cellular organelle, a virus or an antibody to the device. Examiner would like to point out Kaye et al. teach application for the device in many aspects, including biological assays, biological systems and biological of interest including throughput screens (See page 19, line 2-8). Particularly Kaye et al. also give some, not limited, examples such as enzymes, receptors, signalling systems, receptor genes. *supra*. It is noted that applicant recites the binding partner "that is capable of binding to a moiety to be manipulated", and the binding partner comprises "a cell, cellular organelle, a virus or an antibody". The examples given by Kaye et al. include receptor which is also a cellular organelle on cell surface.

Taken together, the instant invention would still be rendered anticipated under Kaye et al. reference.